

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed November 14, 2006 ("*Office Action*"). At the time of the Office Action, Claims 1-20 were pending in the application. In the Office Action, the Examiner rejects Claims 1-20. Applicants amend Claim 14. Applicants respectfully request reconsideration and favorable action in this case.

Nonstatutory Double Patenting Rejections

The Examiner provisionally rejects Claims 1-20 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-21 of co-pending Application No. 10/807,566. As these are provisional double patenting rejections, Applicants defer the decision to file a terminal disclaimer or traverse the rejections until the Examiner has identified that the present application and co-pending application 10/807,566 include allowable subject matter.

Section 101 Rejections

Claims 14-19 are rejected under 35 U.S.C. §101 because the Examiner contends that the claimed invention is directed to non-statutory matter. Applicants have amended independent Claim 14 to recite logic embodied as a computer program stored on a computer readable medium. Applicants respectfully request withdrawal of these rejections.

Section 103 Rejections

Claims 1-6, 8-12, 14-18, and 20

The Examiner rejects Claims 1-6, 8-12, 14-18, and 20 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,598,187, issued to Ide et al. ("*Ide*"), in view of U.S. Patent App. No. 2004/0061621, issued to Ishida ("*Ishida*"). Applicants respectfully traverse these rejections.

A. The Proposed Combination of *Ide* and *Ishida* Fails to Disclose, Teach, or Suggest Each and Every Element Recited in Claim 1

Applicants respectfully submit that the combination of *Ide* and *Ishida* proposed by the Examiner fails to disclose, teach, or suggest elements specifically recited in Applicants' claims. For example, Claim 1 recites a handheld device comprising:

a control module operable to track movement of the handheld device using the motion detection module, to compare the tracked movement against the remote command gestures to determine a matching gesture, and to identify the one of the commands corresponding to the matching gesture; and
a wireless interface operable to transmit the identified command to a remote receiver for delivery to the remote device.

The Examiner relies on Col. 14, lines 7-47 of *Ide* to teach these elements. See *Office Action*, page 6, ¶ 6. *Ide* states that movements are converted "into digital signals, which are supplied to the motion recognizing section 41." See *Ide*, Col. 14, ll. 30-32. Then, "the motion recognizing section 41 first converts the signals indicating movements with two directions into motion pattern data in the same format as that of the basic data....Then, a motion code indicating the corresponding basic motion pattern is acquired." See *Ide*, Col. 14, ll. 33-43. Finally, the control target device receives the code, and "the control target device executes a control process according to the given motion code." See *Ide*, Col. 14, ll. 46-48. In Claim 1, the *identified command* is transmitted to the remote device. In *Ide*, a code is sent to the remote device and then the device must "execute[] a control process according to the given motion code." See *Ide*, Col. 14, ll. 46-48. Thus, *Ide* does not disclose, teach, or suggest "a wireless interface operable to transmit the identified command to a remote receiver for delivery to the remote device." *Ishida* does not cure this deficiency. For this reason, Applicants respectfully request reconsideration and allowance of Claim 1.

Claims 2-6 depend from Claim 1 and are allowable for at least the reasons discussed above. For analogous reasons, independent Claims 8, 14, and 20 and their respective dependent claims are allowable under 35 U.S.C. 103(a). Accordingly, Applicants respectfully request reconsideration and allowance of Claims 1, 8, 14, and 20 and all claims depending therefrom.

B. The Proposed *Ide-Ishida* Combination is Improper

The rejection of Applicants' claims is also improper because the Examiner has not shown the required teaching, suggestion, or motivation in *Ide*, *Ishida*, or in the knowledge generally available to those of ordinary skill in the art at the time of the invention to combine or modify the *Ide* or *Ishida* references in the manner the Examiner proposes. The rejected claims are allowable for at least this reason.

1. The Obviousness Standard

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention. It is clear based at least on the distinction discussed above that the proposed *Ide-Ishida* combination does not, taken as a whole, suggest the claimed invention, taken as a whole. Respectfully, it appears that the Examiner has merely pieced together disjointed portions of references, with the benefit of hindsight using Applicants' claims as a blueprint, in an attempt to reconstruct Applicants' claims.

The governing Federal Circuit case law makes this strict legal standard clear.¹ According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)).

2. There is No Motivation to Combine *Ide* and *Ishida*

According to the Examiner, "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the handheld device of *Ide* to have a display as taught by *Ishida* such that a user can control the device by viewing the build-in monitor ([0013], [0014] of *Ishida*).” See *Office Action*, page 6, ¶ 6. Applicants respectfully

¹ Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

submit that the Examiner's assertion that it would have been obvious to combine the teachings of *Ide* with the teachings of *Ishida* to purportedly arrive at Applicants' invention is entirely insufficient to support a *prima facie* case of obviousness under 35 U.S.C. 103(a) under the M.P.E.P. and the governing Federal Circuit case law.

Ide refers to his input device as a "spatial control mouse" and repeatedly thereafter as a "mouse." A mouse is typically used to move a cursor on a screen, and the mouse of *Ide* is used in this manner. See *Ide*, Figure 3; Col. 1, ll. 20-24; and Col. 7, ll. 29, 37-38. When using the mouse, the user typically watches the screen to track the movement of the cursor, while one of the user's hands is on the mouse. There is no motivation, either in the cited references or otherwise, to put a viewable display on the mouse of *Ide*. The Examiner has not shown the required motivation to combine or modify the prior art references.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Ide* with *Ishida* in the manner the Examiner proposes, Applicants respectfully submit that the Examiner's conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicants respectfully submit that the rejection of these claims be withdrawn.

Claims 7, 13, and 19

The Examiner rejects Claims 7, 13, and 19 under 35 U.S.C. 103(a) as being unpatentable over *Ide*, in view of *Ishida*, and further in view of WO 01/86920 issued to Lapidot ("*Lapidot*"). Applicants respectfully traverse these rejections.

For the reasons discussed above, Applicants submit that the combination of *Ide* and *Ishida* does not disclose, teach, or suggest all elements specifically recited in Applicants' Claim 1. *Lapidot* does not cure this deficiency. Claim 7 depends from Claim 1, and Claims 13 and 19 both depend from independent claims with limitations similar to Claim 1. For this reason, Applicants respectfully request reconsideration and allowance of Claims 7, 13, and 19.

For the reasons discussed above, Applicants also submit that there is no motivation to combine or modify the *Ide* or *Ishida* references in the manner the Examiner proposes.

ATTORNEY DOCKET NO.
073338.0190
(04-50462 FLA)

PATENT APPLICATION
10/807,562

13

Lapidot does not cure this deficiency. For at least these reasons, Applicants respectfully submit that the rejection of these claims be withdrawn.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad C. Walters, Attorney for Applicants, at the Examiner's convenience at (214) 953-6511.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants



Chad C. Walters
Reg. No. 48,022

Date: February 14, 2007

CORRESPONDENCE ADDRESS:

at Customer No. **05073**